

By



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,197	06/15/2001	Pierre Quentin	229.009	8015

23598 7590 08/25/2005

BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C.
250 E. WISCONSIN AVENUE
SUITE 1030
MILWAUKEE, WI 53202

EXAMINER

PEREZ, ANGELICA

ART UNIT	PAPER NUMBER
----------	--------------

2684

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/882,197	QUENTIN ET AL.	
	Examiner	Art Unit	
	Perez M. Angelica	2684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

1. The following is an examiner's statement of reasons for allowance:

Regarding claims 1 and 7, the previous art of record teaches of a method for management of a communications module, and a detachable microcircuit for a terminal comprising means, including a microprocessor, to set up a man/machine interface in which the microcircuit and the terminal communicate by sending messages through a module-terminal connection between the module and the terminal.

The previous art of record fails to teach where messages are sent from the microcircuit to the terminal, in the module, messages sent by the microcircuit are distributed between the module and the terminal to limit the communications on the module-terminal connection and to limit an activity, related to a processing of a message, of the microprocessor of the terminal.

2. Claims 2-6 and 8 are dependent upon claims 1 and 7; therefore, the examiner gives the same reasons for allowance as set forth above.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heinonen (Heinonen et al.; US Patent No.: 5,887,266) in view of Kowalski (Kowalski et al.; 199,907).

Regarding claim 9, Heinonen teaches of a communications device for a terminal comprising: (figure 1) a communications module (figure 1, item 6) including a processor (figure 3b, item "CPU"), a memory (figure 3b, items "EEPROM", "RAM" and "ROM") and a link that connects the module to the terminal (figure 1, item 14); and a detachable microcircuit detachably connected to the module and configured to enable the terminal to communicate with the telecommunications network via the communications module (column 59-67).

Heinonen does not teach of an antenna for wirelessly communicating with a telecommunications network.

In related art, concerning an electronic micro-module, Kowalski teaches of an antenna for wirelessly communicating with a telecommunications network (title and abstract).

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Heinonen's method for management of a communications module with Kowalski's antenna in order to provide reliable connection, as taught by Kowalski.

Regarding claim 15, Heinonen teaches of a communications system comprising (figure 1): a terminal equipped with a processor and memory (column 1, lines 7-20); a communications module (figure 1, item 6) including a processor (figure 3b, item "CPU"), a memory that holds communication task instructions and SIM card instructions (figure 3b, items "EEPROM", "RAM" and "ROM"), a modem and an antenna connected to the modem for wirelessly communicating with a cellular telecommunications network and a link that connects the module to the terminal (figure 1, item 14); and a SIM connected to the module and configured to enable the terminal to communicate with the cellular telecommunications network to manage e-mail, navigate the Internet, or access a subscription service via the telecommunications network (column 59-67 and columns 11 and 12, lines 64-67 and 1-4; where the multi-functional applications also include e-mail, navigate the Internet).

Heinonen does not teach of an antenna for wirelessly communicating with a telecommunications network.

In related art, concerning an electronic micro-module, Kowalski teaches of an antenna for wirelessly communicating with a telecommunications network (title and abstract).

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Heinonen's method for management of a communications module with Kowalski's antenna in order to provide reliable connection, as taught by Kowalski.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heinonen in view of Kowalski as it applies to claim 15, and further in view of Bruner (Bruner et al.; US Patent No.: 6,141,564 A).

Regarding claim 16, Heinonen in view of Kowalski teaches all the limitations of claim 15.

Heinonen in view of Kowalski does not specifically teaches where the memory of the terminal holds a detachable microcircuit instruction set, and the memory of the communications module holds detachable microcircuit instructions codes.

In related art, concerning a method of sharing a SIM card between two masters, Bruner teaches where the memory of the terminal holds a detachable microcircuit instruction set, and the memory of the communications module holds detachable microcircuit instructions codes (columns 1, 2, lines 60-67 and 1-17, respectively and column 4, lines 9-14).

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Heinonen' in view of Kowalski method for management of a communications module with Bruner's instruction sets in order to be able to initiate communications directed towards the SIM, as taught by Bruner.

Regarding claim 17, Heinonen in view of Kowalski and further in view of Bruner teaches all the limitations of claim 15. Heinonen further teaches where the detachable microcircuit comprises a processor and memory that holds processor instruction codes (figure 3b; where the it is inherent for SIM cards to hold instructions regarding the processor).

Regarding claim 18, Heinonen in view of Kowalski and further in view of Bruner teaches all the limitations of claim 15. Heinonen further teaches where the detachable microcircuit comprises a SIM (column 4, lines 62-66).

Regarding claim 19, Heinonen in view of Kowalski teaches all the limitations of claim 17. Heinonen further teaches where the SIM comprises a SIM toolkit card (columns 11 and 12, lines 64-67 and 1-4; where the information timetables, stock prices and exchange rates enhanced applications are enabled with a SIM toolkit).

6. Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heinonen in view of Kowalski as it applies to claim 9, and further in view of Erikson (Erikson, Rich; US Patent No.: 6,622,018 B1).

Regarding claims 10, Heinonen in view of Kowalski teaches all the limitations of claim 9. Heinonen further teaches where the detachable circuit comprises a SIM (column 4, lines 62-66).

Heinonen in view of Kowalski does not teach where the terminal comprises a personal digital assistant, the communications module is connected by PCMCIA link to the terminal.

In relate art, concerning a portable device control console with wireless connections, Erikson teaches where the terminal comprises a personal digital assistant (figure 3, column 5, lines 25-31), the communications module is connected by PCMCIA link to the terminal (columns 7 and 8, lines 64-67 and 1-3, respectively).

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Heinonen in view of Kowalski apparatus with Erikson's PCMCIA standards in order to allow connectivity with external devices, as taught by Erikson.

Regarding claim 12, Heinonen in view of Kowalski teaches all the limitations of claim 9. Heinonen further teaches where the link is a wireless link that connects the communications module to the terminal (figure 1, item 14; representing a wireless connection and column 1, lines 38-45), and the detachable microcircuit comprises a SIM (column 4, lines 62-66).

Heinonen in view of Kowalski does not teach where the terminal comprises a personal digital assistant, In relate art, concerning a portable device control console with wireless connections, Erikson teaches where the terminal comprises a personal digital assistant (figure 3, column 5, lines 25-31), the communications module is connected by PCMCIA link to the terminal (columns 7 and 8, lines 64-67 and 1-3, respectively).

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Heinonen in view of Kowalski apparatus with Erikson's PCMCIA standards in order to allow connectivity with external devices, as taught by Erikson.

Regarding claim 13, Heinonen in view of Kowalski teaches all the limitations of claim 12. Erekson further teaches where the wireless link comprises a Bluetooth link (column 7, lines 10-16).

Regarding claim 14, Heinonen in view of Kowalski and further in view of Erekson teaches all the limitations of claim 13. Heinonen further teaches where the SIM comprises a SIM toolkit card (column s 11 and 12, lines 64-67 and 1-4; where the information timetables, stock prices and exchange rates enhanced applications are enabled with a SIM toolkit).

Regarding claim 20, Heinonen teaches of a communications system comprising (figure 1): an apparatus equipped with a processor and memory that holds a SIM message instructions (column 1, lines 7-20); a communications module (figure 1, item 6) including a processor (figure 3b, item "CPU"), a memory that holds communication task instructions and SIM card instructions (figure 3b, items "EEPROM", "RAM" and "ROM"), a modem and an antenna connected to the modem for wirelessly communicating with a cellular telecommunications network and a link that connects the module to the terminal (figure 1, item 14); and a SIM connected to the module and configured to enable the terminal to communicate with the cellular telecommunications network to manage e-mail, navigate the Internet, or access a subscription service via the telecommunications network (column 59-67 and columns 11 and 12, lines 64-67 and 1-4; where the multi-functional applications also include e-mail, navigate the Internet).

Heinonen does not teach of an antenna for wirelessly communicating with a telecommunications network.

In related art, concerning an electronic micro-module, Kowalski teaches of an antenna for wirelessly communicating with a telecommunications network (title and abstract).

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Heinonen's method for management of a communications module with Kowalski's antenna in order to provide reliable connection, as taught by Kowalski.

Heinonen in view of Kawoski does not teach of a personal digital assistant and cellular network.

In related art, concerning a portable device control console with wireless connections, Erikson teaches where the terminal comprises a personal digital assistant (figure 3, column 5, lines 25-31) and cellular network (columns 4 and 5; where cellular telephones connect to cellular networks).

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Heinonen in view of Kowalski apparatus with Erikson's personal digital assistant in order to provide alternative apparatuses to the user, as taught by Erikson.

Regarding claim 21, Heinonen in view of Kowalski and further in view of Erikson teaches all the limitations of claim 12. Heinonen teaches where the SIM comprises a

Art Unit: 2684

SIM toolkit card that has an onboard processor, onboard memory storage that holds communication instructions and processor instructions (figure 3b).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angelica Perez whose telephone number is 571-272-7885. The examiner can normally be reached on 7:00 a.m. - 3:30 p.m., Monday - Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on (571) 272-7882. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either the PAIR or Public PAIR. Status information

Art Unit: 2684

for unpublished applications is available through the Private PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Information regarding Patent Application Information Retrieval (PAIR) system can be found at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2600's customer service number is 703-306-0377. Conclusion


Angelica Perez
(Examiner)


NAY MAUNG
SUPERVISORY PATENT EXAMINER

Art Unit 2684

August 17, 2005